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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/887,320	06/25/2001	Mutsuo Nakashima	KOJIM-245 D1	6821

23599 7590 09/16/2003

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER

HAMILTON, CYNTHIA

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/16/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/887,320

Applicant(s)

NAKASHIMA ET AL.

Examiner

Cynthia Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-5 and 16-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2-5, 17 and 22-25 is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☒ Claim(s) 18-21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/129,950.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 16 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 15 of U.S. Patent No. 6,309,796 b1. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant claim 16 varies from patent claim 15 only in instant claim 2 wherein the silicone compound is defined differently only at R² at "or alkenyl group having 3 to 8 carbon atoms" wherein the patent claim 16 has 1-8 carbon atoms at this point and in definition of R' wherein the patent claim has cyclic alkylene group and the instant claim 2 has "cyclic alkenylene group". The examiner notes that looking at the position of R' the use of alkenyl is a misnomer because it references monovalent groups and that alkenylene is the proper name for a divalent ethylenically unsaturated carbon group as set forth in the attached Class 532 definitions on page 532-5 and 532-6 with regard to acyclic unsaturated carbon groups. This difference from alkenyl to alkenylene is seen as a correction in language that is clear to workers of ordinary skill in the art when they see the structure in which R' is present. Thus, the instant resist of claim 16 differs from the patent resist of claim 15 only in that when R² is present as an alkenyl group it is limited to 3-8 carbon atoms which is narrower than the 1-8 carbons in the patent resist. The examiner notes that an alkenyl group must have at least 2 carbons in it to be an alkenyl group. Thus, the difference between the patent claim and the instant claim is really 2-8 carbons versus 3-8

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carbons. Compounds which are homologs (compounds differing regularly by the successive addition of the same chemical group, e.g., by -CH₂- groups) are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. In re Wilder, 563 F.2d 457, 195 USPQ 426 (CCPA 1977). See also In re May, 574 F.2d 1082, 197 USPQ 601 (CCPA 1978) (stereoisomers prima facie obvious). Thus, the elimination of one carbon from the range of an alkenyl group in instant claim 16 is held prima facie obvious in view of the homologous nature of C2 and C3 alkenyl groups. There is a difference in scope between the patent claimed invention and the instant claimed invention so there is no issue of claiming the exact same resist composition in both places.

3. Applicant's arguments filed July 2, 2003 have been fully considered but they are not persuasive. Applicants argue that because claim 16 is dependent upon claim 3 which was restricted "from the parent" then "it only follows that subject matter dependent thereon would also be restricted. In other words, since the compounds of claim 3 were found patentably distinct from the previously patented compounds, it follows that the compositions of claim 16 containing the claim 3 compounds are patentably distinct from previously added compositions. This is particularly the case where the novelty derives from the compounds." The examiner notes that the composition claim 16 was not present for examination at the time the restriction was made in October 4, 1999 in the parent application. The original restriction separated original claims 6-14 drawn to a resist composition with photoacid present as Group IV. The elected group in that application was Group I inclusive of claim 1 originally. Group IV included claim 6 compositions which were dependent upon claim 1 and claim 7 compositions which were drawn to compositions inclusive of polymers of those like original claim 2 and claim 8 read on compositions inclusive of polymers of those like original claim 3. Thus, the examiner did group the photoresist compositions together and restricted them from the claims drawn to compounds alone. This was done because all of the compositions were searched in the same area and thus restriction would not have been proper because an undue burden did not exist upon the examiner to examine all of the claims directed to the photoresist compositions in claims 6-14. Such a burden did exist with respect to the search for the separate compounds. Applicants in their election letter filed November 5, 1999 in the parent application argued successfully to remove

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the restriction requirement between original Groups I and IV. The examiner agreed that such a restriction was improper and removed it in the Office action mailed February 29, 2000. Thus, there was no restriction between original claims 1, i.e. Group I, and 6-14, i.e. Group IV in the Parent application as of the filing date of this application in June 25, 2001. Thus, the photoresist compositions with the polymers of Groups I, II and III were not separated from each other in the original restriction requirement in the parent application and applicants persuaded the examiner prior to filing of this application to remove the restriction requirement between Groups I and IV. It is clear from the record that the examiner did put the photoresist compositions all together and did not separate them based upon the original claims drawn only to the polymers. She did try to keep separate the compositions from the compounds, but applicants argued to remove this separation. The photoresist composition of instant claim 16 was allowed without determining the patentability of the compound of claim 3. The issue as to whether the compound of claim 3 was novel and unobvious was not considered in the allowance in the parent application of claim 15 in Patent No. 6,309,796 B1. The rejection stands because Group IV was already examined in the parent application and claim 16 would have been part of Group IV if presented in the original application. The examiner notes that original groups II and III are under examination in this application as well. The examiner notes that had instant claims 17-25 been present in the original application they too would have been made part of Group IV because all had a photoacid generator present which grouped them together in such a manner that the search for all was essentially the same. MPEP 804.01 sets forth the situations where the prohibition of double patenting rejections under 35 U.S.C. 121 does not apply. One is as follows:

(B) The claims of the different applications or patents are not consonant with the restriction requirement made by the examiner, since the claims have been changed in material respects from the claims at the time the requirement was made. For example, the divisional application filed includes additional claims not consonant in scope to the original claims subject to restriction in the parent. *Symbol Technologies, Inc.*

v. Opticon, Inc., 935 F.2d 1569, 19 USPQ2d 1241 (Fed. Cir. 1991) and *Gerber Garment Technology, Inc. v. Lectra Systems, Inc.*, 916 F.2d 683, 16 USPQ2d 1436 (Fed. Cir. 1990). In order for consonance to exist, the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction must be maintained. 916 F.2d at 688, 16 USPQ2d at 1440.

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and

(F) The claims of the second application are drawn to the "same invention" as the first application or patent. *Studiengesellschaft Kohle mbH v. Northern Petrochemical Co.*, 784 F.2d 351, 228 USPQ 837 (Fed. Cir. 1986).

In this Divisional application applicants did not maintain the line of demarcation between the independent and distinct inventions identified by the examiner in the requirement for restriction in the original patent application. In filing claims 16-20 in their preliminary amendment of June 25, 2001, applicants presented additional claims not consonant in scope to the original claims subject to restriction in the parent. The examiner made clear in the requirement that the compositions with the photoacid present were separate from that of the compound claims. Applicants chose to add such composition claims to their divisional application. Only claim 16 resulted in an obvious double patenting rejection; however, claims 17-25 all would have properly been part of Group IV as set forth in the original restriction requirement. The rejection stands. The examiner believes it to be properly made and an exception as set forth in MPEP 804.01 (B) and/or (F) under 35 U.S.C 121.

4. Claims 2-5, 17 and 22-25 are allowed.

5. Claims 18-21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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7. *Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is (703) 308-3626. The examiner can normally be reached on Monday-Friday, 9:30 am to 5:00 pm.*

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on (703) 308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305 0661.


CYNTHIA HAMILTON
PRIMARY EXAMINER

Primary Examiner Cynthia Hamilton
September 14, 2003